

## REMARKS

Claims 41-56 are pending in the present application.

Please also initial and return to us the PTO-1449 form submitted with the Information Disclosure Statement on May 24, 2000, after your review of the references submitted therewith.

### Rejections under 35 U.S.C. § 102(e)

According to the Office Action, claims 41-47, and 52-56 stand rejected under Section 102(e) as allegedly being anticipated by U.S. Patent No. 6,375,871 to Bentsen et al. (hereafter referred to as "Bentsen").

It is well established that a patent is available as prior art as of its critical reference date. Bentsen was filed June 18, 1998 and does not claim priority to another application. Bentsen's critical reference date is therefore June 18, 1998.

The instant application, however, benefits from an application filed prior to the above mentioned critical reference date. According to the MPEP:

In order for a national stage application (of international application "X") to obtain benefit under 35 U.S.C. §120 and 365(c) of a prior filed copending nonprovisional application ..., the national stage application must comply with the requirements set forth in 37 CFR 1.78(a)(1) through 1.78(a)(3). The prior nonprovisional application ... must name as an inventor at least one inventor named in the later filed international application "X" and disclose the named inventor's invention claimed in at least one claim of the national stage application in the manner provided by the first paragraph of 35 U.S.C. §112. The national stage application must contain a reference to the prior nonprovisional ... application (either in an application data sheet (37 CFR 1.76) or in the first sentence of the specification), identifying it by application number (series code and serial number) ... and indicating the relationship of the application.

MPEP § 1893.03(c) (8th ed.). In this case the subject national application (09/509,337) is entitled to the benefit of the prior nonprovisional application (08/950,403) because all the above mentioned requirements are met. (1.) The inventors of the prior nonprovisional application are

identical to the inventors of this national stage application. (2.) The prior nonprovisional application discloses subject matter claimed in the subject national stage application. In particular, amongst other common subject matter, figures 1-6 and the corresponding text of the national stage application were disclosed in the prior nonprovisional application and this subject matter supports the pending claims. (3.) By this amendment, the national stage application contains a specific reference to the prior nonprovisional application in the first sentence of the application. A claim of priority to the above mentioned international application and the prior nonprovisional application was also made in an executed Declaration submitted June 8, 2000 for the subject national stage application.

Although this reference is being added to the specification after the time period specified in 37 CFR 1.78(a)(2), "[t]he time period requirement under 37 CFR 1.78(a)(2) ... is only applicable to utility ... applications filed on or after November 29, 2000." MPEP § 201.11, page 200-69 (8th ed.). This national stage application has a filing date of June 13, 2000 which is prior to the effective date of new rule 1.78(a)(2). Accordingly, the time period requirement of this rule does not apply to this application and Applicants may perfect their priority claim at this time.

In summary, Bentsen's critical reference date (June 18, 1998) is after the subject application's priority date (October 15, 1997). Consequently, Bentsen is not available as prior art against the pending claims and may not be properly used in a rejection under Section 102. Withdrawal of the rejection of claims 41-47, and 52-56 under 35 U.S.C. § 102(e) based on Bentsen is respectfully requested.

### **Rejections under 35 U.S.C. § 103(a)**

The Office Action also states that claims 48-51 are unpatentable under 35 U.S.C. § 103(a) over Bentsen and further in view of U.S. Patent No. 5,376,252 to Ekstrom et al. ("Ekstrom").

As discussed above in connection with the rejection under 35 U.S.C. § 102, Bentsen is not available as prior art against the pending claims. Consequently, Bentsen may not be applied in this obviousness rejection.

Further, Ekstrom alone is not enough to make a prima facie case of obviousness. A prima facie case of obviousness requires, amongst other things, that the reference(s) teach or suggest all claim limitations. MPEP § 2143 (8th ed.). Ekstrom does not teach or suggest all claim limitations found in claims 48-51. In particular, amongst other things, Ekstrom does not describe or suggest "films extending to and being fed from supply rolls." This is a claim limitation in each of claims 48-51. Accordingly, the requirements of a prima facie case of obviousness have not been met. Withdrawal of the rejection under 35 U.S.C. § 103(a) is respectfully requested.

### **CONCLUSION**

Applicant has, by way of the amendments and remarks presented herein, made a sincere effort to overcome rejections and address all issues that were raised in the outstanding Office Action. Accordingly, reconsideration and allowance of the pending claims are respectfully requested. If it is determined that a telephone conversation would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. **427922001500**.

Respectfully submitted,

Dated: October 28, 2002

By: 

Richard R. Batt  
Registration No. 43,485

Morrison & Foerster LLP  
755 Page Mill Road  
Palo Alto, California 94304-1018  
Telephone: (650) 813-5616  
Facsimile: (650) 494-0792

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

On page 1, after the title, a new paragraph has been added.

v